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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MADAN MOHAN R. APPIAH, TAD DENNIS BROCKWAY,
and RITU BAHL

Appeal 2007-3589
Application 09/454,221¹
Technology Center 2100

Decided: April 8, 2008

Before LANCE LEONARD BARRY, JEAN R. HOMERE, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Filed on Dec. 09, 1999. The real party in interest is Microsoft Corp.

I. STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1 through 40. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

Appellants invented a method and system for enabling applications running on a server computer (52) to print data to a printer (88) attached to a client computer (54). (Spec. 3.) As depicted in Figure 2, upon receiving from the client computer (54) a driver identifier for the printer (88), the server computer (52) selects from its driver library (68) a driver that most closely matches the identified driver received from the client (54). (*Id* 7-9.) The selected driver is installed at the server to enable its local applications to print to the printer (88). (*Id.*)

Independent claim 1 further illustrates the invention. It reads as follows:

1. A method in a server-client environment, the method comprising:

receiving at the server a driver identifier for a printer that is attached to the client;

using the driver identifier to select a closest matching driver of a plurality of drivers to install at the server; and

installing, at the server and not at the client, the selected driver in order to enable applications executing on the server to print to the printer using the installed driver.

The Examiner relies on the following prior art to reject the claims on appeal:

Kathail	US 5,802,365	Sep. 01, 1998
Poger	US 6,772,420 B1	Aug. 03, 2004

The Examiner rejects the claims on appeal as follows:

1. Claims 1 through 28 and 33 through 40 stand rejected under 35 U.S.C. § 112, first paragraph as containing subject matter which was not described in the Specification in such a way to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention.
2. Claims 1 through 40 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Poger and Kathail.

FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

Poger

1. Poger discloses a method and system for selecting and installing a suitable driver software on a network server to enable applications running on the server to communicate with a device added to the network. (Col. 2, ll. 5-13, col. 5, ll. 40-43.)
2. As depicted in Figures 1, 2, a network device (115), including an output device (156) and a driver software (160), is connected to a configuration server (110) via a network (120). (Col. 3, ll. 44-46.)

3. Upon the network device (115) being added to the network, the server (110) compares the manufacturer type of the network device (115) with information in its hardware address database (140) and driver software database (142) to identify the type and location of the driver software (160) required to communicate with the network device. The identified driver software is subsequently installed at the server (110) to enable applications running thereon to communicate with the network device (115). (Col. 3, ll. 50-64.)

Kathail

4. As depicted in Figure 1, Kathail discloses a computer system (120) being connected to a plurality of devices including a storage device (104), a display device (105), an output device (e.g. a printer). (Col. 6, ll. 1-6.)

5. Kathail discloses determining the appropriate driver for any of the devices being added to the computer system by sequentially applying drivers in a driver candidate list to the device sought to be added. (Col. 4, ll. 54-57, col. 6, ll. 8-39.)

PRINCIPLES OF LAW

A. WRITTEN DESCRIPTION

“[T]he ‘essential goal’ of the description of the invention requirement is to clearly convey the information that an applicant has invented the subject matter which is claimed.” *In re Barker*, 559 F.2d 588, 592 n.4 (CCPA 1977). Another objective is to put the public in possession of what the applicant claims as the invention. *See Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1566, (Fed. Cir. 1997).

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. *See, e.g., Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563. An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, (Fed. Cir. 1997). Possession may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was “ready for patenting” such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention. *See, e.g., Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68 (1998); *Eli Lilly*, 119 F.3d at 1568; *Amgen, Inc. v. Chugai Pharmaceutical*, 927 F.2d 1200, 1206 (Fed. Cir. 1991) (one must define a compound by “whatever characteristics sufficiently distinguish it”). There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. *In re Wertheim*, 541 F.2d 257, 263 (CCPA 1976) (“we are of the opinion that the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims”).

B. OBVIOUSNESS

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

The Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966), stated that the following factual inquiries underpin any determination of obviousness:

Under § 103, [1] the scope and content of the prior art are to be determined; [2] differences between the prior art and the claims at issue are to be ascertained; and [3] the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such (4) secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.

Where the claimed subject matter involves more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement, a holding of obviousness must be based on "an apparent reason to combine the known elements in the fashion claimed." *KSR Int'l v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41 (2007). That is, "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of

obviousness.” *Id.*, 127 S. Ct. at 1741, (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Such reasoning can be based on interrelated teachings of multiple patents, the effects of demands known to the design community or present in the marketplace, and the background knowledge possessed by a person having ordinary skill in the art. *KSR*, 127 S. Ct. at 1740-41.

ANALYSIS

A. 35 U.S.C. 112, para. 1

Independent claim 1 recites in relevant part installing, at a server and not at a client, a selected drive to enable applications running on the server to print to a printer attached to the client. (Claims Appendix.) The Examiner submits that the recited limitation of installing the selected driver on the server and not on the client is not supported by Appellants’ originally filed disclosure. Therefore, the Examiner submits that claim 1 fails to comply with the written description requirement. (Ans. 5, 11.) In response, Appellants argue that the cited limitation is implicit from the definition of the printer driver in the originally-filed disclosure. (Reply Br. 12.) Therefore, the first issue before us is whether the “printer driver,” as defined in Appellants’ originally-filed disclosure, sufficiently describes installing a selected driver at the server and not at the client to comply with the written description requirement under 35 U.S.C. § 112, para. 1? We answer this inquiry in the affirmative.

Appellants’ originally filed disclosure defines “printer driver” as a printer-specific software program that provides an interface between a printer and a server, and allows the server to provide print functions via the

printer. (Spec. 7, ll. 8-12.) The foregoing definition clearly indicates that the “*printer driver*” is an interface between the server and the printer. This implies that the printer driver software is at least installed at the server to perform its interface function between the server and the printer. This definition, by specifically tying the driver to the server and the printer, impliedly excludes installing that same driver at the client. We therefore agree with Appellants that one of ordinary skill in the relevant art, having read the originally-filed disclosure, would readily ascertain from the disclosed definition that the “printer driver” is installed at the server and not at the client. Such disclosure is at least implied from the cited definition. To comply with the written description requirement of 35 U.S.C. § 112, para. 1, each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure. See MPEP § 2163.05. It follows that Appellants have shown that the Examiner erred in finding that claim 1 fails to comply with the written description requirement.

A. 35 U.S.C. 103

Appellants argue that the combination of Poger and Kathail does not teach installing, at a server and not at a client, a selected drive to enable applications running on the server to print to a printer attached to the client, as recited in independent claim 1. (Reply Br. 14-16.) In response, the Examiner avers that Poger’s disclosure of installing at a server the matching driver of a network device, taken in combination with Kathail’s disclosure of

installing a printer driver at a computer system attached to said printer, teaches the cited limitations. (Ans. 6-7, 12-13.)

Therefore, the issue before us is whether one of ordinary skill in the art would have found that Poger's disclosure of installing at a server the matching driver of a network device, taken in combination with Kathail's disclosure of installing at a computer system a driver of an attached printer, teaches the invention as recited in representative claim 1. We answer this inquiry in the negative.

As set forth in the findings of fact section, Poger teaches, upon adding a device to a network, the server determines the matching driver of the added device to enable applications running on the server to communicate with the added device. (FF 1-3.) Further, Kathail teaches, upon a printer being attached to a computer system, it determines which of its drivers best suits the added printer to enable applications running on the computer system to print data to the printer. (FF 4-5.) As acknowledged by the Examiner, Poger does not teach a client computer having a printer attached thereto to enable the printer driver to be installed at a server, and not at a client. However, Kathail's teachings fail to cure these deficiencies. Despites Kathail's teaching of installing a printer driver, such installation is made at a client computer. One of ordinary skill in the art would have readily recognized that the proffered combination teaches installing a printer driver at a client computer, and installing a network driver at the server. The suggested combination, is however, silent on installing such printer driver at the server and not at the client, as required by independent claim 1. It follows that Appellants have shown that the Examiner erred in concluding

that the combination of Poger and Kathail renders independent claim 1 unpatentable.

Claims 2 through 40 recite the limitations of representative claim 1 discussed above. It follows for the same reasons set forth above that Appellants have shown that the Examiner erred in concluding that the combination of Poger and Kathail renders independent claims 2 through 40 unpatentable.

DECISION

We reverse the Examiner's decision rejecting claims 1 through 40.

REVERSED

pgc

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